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REMARKS

Status of the claims:

With the above amendments, claim 3 has been amended and claims 4-19 have been added. Claims 1-19 are pending and ready for further action on the merits. No new matter has been added by way of the above amendments. Support for the amendment to claim 3 can be found from original claim 1 and also at page 1, lines 12-18. Support for new claims 4-7 can be found at page 4, lines 16-19. Support for new claims 8-9 can be found at page 5, lines 5-8. Support for new claims 10-11 can be found at page 7, lines 19-22. Support for new claims 12-15 can be found at page 7, line 23 to page 8, line 2. Support for new claims 16-19 can be found at page 8, lines 20-23. Reconsideration is respectfully requested in light of the following remarks.

Rejections under 35 USC §101

Claim 3 has been rejected under 35 USC §101 as not reciting a statutorily recognized form of claim in the United States. Applicants have amended claim 3 so that it is now a statutorily recognized form of claim in the United States. Applicants believe that with this amendment that the rejection has been obviated. Withdrawal of the rejection is warranted and respectfully requested.

Rejections under 35 USC §112, second paragraph

Claim 3 has been rejected under 35 USC §112, second paragraph as being indefinite for a failure to recite specific method steps. Claim 3 has been amended to recite specific method steps. Applicants believe that with this amendment that the rejection has been obviated. Withdrawal of the rejection is warranted and respectfully requested.

Rejections under 35 USC §102

Claims 1-3 are rejected under 35 USC §102(b) as being anticipated by Mitsui '135 (JP 06-160135). Applicants respectfully point out that Mitsui '135 is an application number and JP 08-025580 is the publication of the application. Nevertheless, for the purposes of the following discussion, Applicants will refer to the Mitsui publication as Mitsui '135.

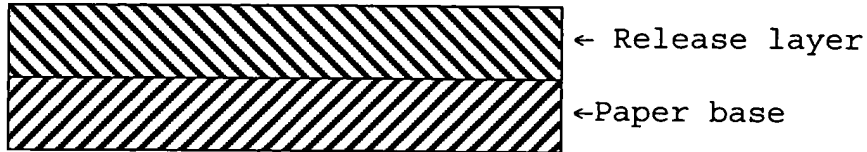
Claims 1 and 2 are rejected under 35 USC §102(b) as being anticipated by Hashimoto '694 (JP 05-104694) with additional evidence provided by Shigemoto '979 (US Patent No. 5,080,979).

These rejections are traversed for the following reasons.

Present Invention and its advantages

To aid the Examiner's understanding of the instant invention, a description of the features of the invention are explained here.

The release paper according to the instant invention may be illustrated as follows.



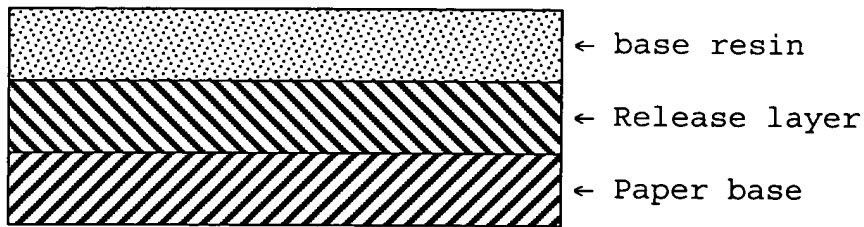
The release layer and paper base are bonded strongly (please see page 10, lines 10-17 in the instant written description) and no peeling occurs at the interface of the release layer and the paper base. The release layer may have a relief pattern on its surface.

One of the features of the instant invention is that the release layer is made of a specific resin. That is, the release layer comprises 4-methyl-1-pentene/ α -olefin copolymer having the α -olefin proportion of 6 to 8% by weight. The invention can be best understood by comparing the Working Examples to the Comparative Examples in the instant written description. It is shown in these examples that the claimed invention exhibits simultaneously low values with respect to crystallinity and the orientation coefficient of the release layer resin before and after heating. Moreover, the instantly claimed invention is excellent in flexibility and heat resistance. See pages 18 and 19 of the written description.

The production of the synthetic leather is illustrated as follows. Basically, the process features thereof are commonly

known in the art except for the use of the specific release paper defined above.

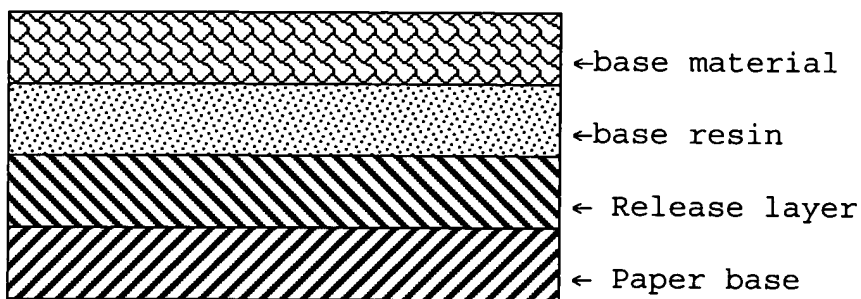
The 1st step comprises coating a base resin onto the release surface layer of the release paper as is illustrated in the below figure.



The base resin is, for example, a polyurethane resin or the like.

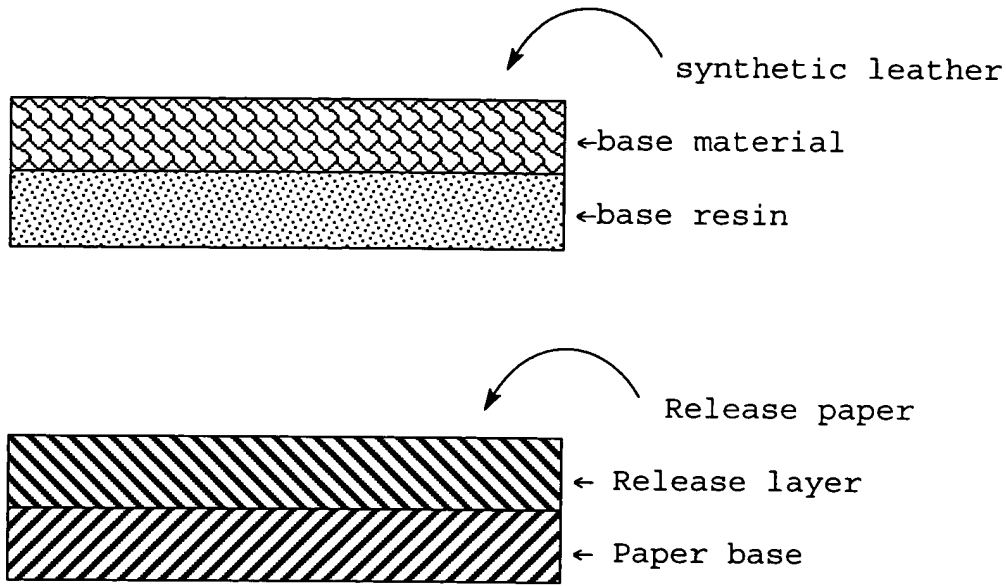
The 2nd step comprises drying the coated base resin to thereby obtain a base resin layer on the release layer.

The 3rd step comprises bonding a base material to the resin layer as is indicated in the below figure.



The base material is, for example cloth or a similar material.

The 4th step comprises removing the release paper from the resin base layer as is indicated in the below figure.



When the release layer has a relief pattern on the surface thereof, the pattern is transferred onto the base resin layer.

As is clear from the above, the synthetic leather is different from the release paper. That is, the synthetic leather does not comprise the release paper.

Removal of the Rejection Over Mitsui '135

Mitsui '135 fails to disclose the specific release layer as defined in the present invention, and therefore, the effects attained thereby. Accordingly, Mitsui '135 cannot anticipate nor can it render obvious the instant invention.

The release layer of Mitsui '135 is made of a polymer composition (polymer alloy) comprising 80-97 parts by weight of (A) 4-methyl-1-pentene polymer, and 3-20 parts by weight of (B) ethylene/ethyl acrylate copolymer.

Mitsui '135 intends to improve wettability of the release layer to a water-soluble or a water-dispersible resin. In the working embodiments of Mitsui '135, the α -olefin (1-decene) content in the (A) 4-methyl-1-pentene polymer is 2.2%. If the release layer is made of a polymer alloy comprising 80/20 of (A)/(B), the 1-decene content in the release layer is 1.76 ((80%)(2.2%)). If the release layer is made of a polymer alloy comprising 97/3 of (A)/(B), the 1-decene content in the release layer is 2.13 ((97%)(2.2%)). In either case, the content of α -olefin (1-decene) falls outside of the claimed range. Accordingly, for this reason alone, Mitsui '135 cannot anticipate the instant invention.

Further, the release layer of Mitsui '135 is made of a polymer comprising 4-methyl-1-pentene polymer and ethylene/ethyl acrylate copolymer. In contrast, the release layer of the instant invention is made of a 4-methyl-1-pentene/ α -olefin copolymer. Thus, the release layer of Mitsui '135 is drastically different from the release layer of the instant invention. Accordingly, Mitsui '135 cannot anticipate the instant invention because Mitsui '135 fails to disclose the elements of the instant invention. Withdrawal of the rejection is warranted and respectfully requested.

Removal of the Rejection over Hashimoto '694

In Hashimoto '694, DX820 is used in the working embodiment. DX820 is a copolymer resin from Mitsui Petrochemical Industries, Ltd., which later became Mitsui Chemicals, Inc. Accordingly, Applicants of the instant invention are familiar with this resin.

DX820 has a 1-decene content that is 3 weight % or less. Accordingly, because the 1-decene content in Hashimoto '694 is less than that of the instantly claimed invention, Hashimoto '694 cannot anticipate nor can it render obvious the instant invention because Hashimoto '694 fails to disclose the elements of the instant invention. The rejection is inapposite. Withdrawal of the rejection is warranted and respectfully requested.

Rejections under 35 USC §103

Claims 1-3 are rejected under 35 USC §103(a) as being unpatentable over Mitsui '135 (JP 06-160135). This rejection is traversed for the following reasons.

Instant Invention

The instant invention, as recited in claim 1, relates to a release paper comprising a paper base laminated with a release layer. The release layer comprises a 4-methyl-1-pentene resin,

which is a copolymer of 4-methyl-1-pentene and an α -olefin other than 4-methyl-1-pentene. The α -olefin is contained in a proportion of 6 to 8% by weight.

Disclosure of Mitsui '135

Mitsui '135 discloses a release paper that is said to be superior in heat resistance and wettability and is said to be suitably used in a process of producing a synthetic leather using a water-soluble or water-dispersible resin. The release paper comprises a paper substrate and a release layer laminated on the paper substrate. The release layer is made of a 4-methyl-1-pentene polymer composition that is 80-97 parts by weight (A) 4-methyl-1-penten polymer and 3-20 parts by weight (B) ethylene-ethyl acrylate copolymer.

Mitsui '135 fails to disclose the α -olefin is contained in a proportion of 6 to 8% by weight.

Removal of the Rejection over Mitsui '135

The Examiner asserts that there is overlap between the instant invention and Mitsui '135. Applicants disagree.

Mitsui '135 fails to disclose the specific release layer as defined in the present invention, and therefore, the effects attained thereby. Accordingly, Mitsui '135 cannot render obvious the instant invention.

In particular, the release layer of Mitsui '135 is made of a polymer composition (polymer alloy) comprising 80-97 parts by weight of (A) 4-methyl-1-pentene polymer, and 3-20 parts by weight of (B) ethylene/ethyl acrylate copolymer.

Mitsui '135 intends to improve wettability of the release layer to water-soluble or water-dispersible resin. In the working embodiments of Mitsui '135, α -olefin (1-decene) content in the (A) 4-methyl-1-pentene polymer is 2.2%. If the release layer is made of polymer alloy comprising 80/20 of (A)/(B), 1 decene content in the release layer is 1.76 $((80\%)(2.2\%))$. If the release layer is made of polymer alloy comprising 97/3 of (A)/(B), 1-decene content in the release layer is 2.13 $((97\%)(2.2\%))$. In either case, the content of α -olefin (1-decene) falls outside of the claimed range.

Thus, Applicants assert that the Examiner has failed to make out a *prima facie* case of obviousness with regard to the 35 USC §103(a) rejection over Mitsui '135. Three criteria must be met to make out a *prima facie* case of obviousness.

- 1) There must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.
- 2) There must be a reasonable expectation of success.

- 3) The prior art reference (or references when combined) must teach or suggest all the claim limitations.

See MPEP §2142 and *In re Vaeck*, 20 USPQ2d 1438 (Fed. Cir. 1991). In particular, the Examiner has failed to meet the third element to make a *prima facie* obviousness rejection. Mitsui '135 fails to disclose or suggest an α -olefin other than 4-methyl-1-pentene wherein the α -olefin is contained in a proportion of 6 to 8% by weight. Thus, the rejection is inapposite.

For this reason alone, Mitsui '135 cannot render obvious the instant invention.

Further, the release layer of Mitsui '135 is made of a polymer comprising 4-methyl-1-pentene polymer and ethylene/ethyl acrylate copolymer. In contrast, the release layer of the instant invention is made of a 4-methyl-1-pentene/ α -olefin copolymer. Thus, the release layer of Mitsui '135 is drastically different from the release layer of the instant invention. Accordingly, Applicants submit for this reason, Mitsui '135 cannot render obvious the instant invention. Withdrawal of the rejection is warranted and respectfully requested.

With the above remarks and amendments, it is believed that the claims, as they now stand, define patentable subject matter such that passage of the instant invention to allowance is warranted. A Notice to that effect is earnestly solicited.

If any questions remain regarding the above matters, please contact Applicant's representative, T. Benjamin Schroeder (Reg. No. 50,990), in the Washington metropolitan area at the phone number listed below.

Pursuant to the provisions of 37 C.F.R. §§ 1.17 and 1.136(a), the Applicants hereby petition for an extension of two (2) months to December 7, 2003 in which to file a reply to the Office Action. The required fee of \$420.00 is enclosed herewith.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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By 

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